

**REMARKS**

This Amendment, filed in conjunction with a Request for Continued Examination (“RCE”), responds to the Final Office Action mailed 12 February 2008. The filing of this Amendment and RCE is permissible under 37 C.F.R. § 1.114. *See* M.P.E.P. § 706.07(h). Claim 1 has been amended and claim 3 has been canceled without prejudice. New claims 15-17 have been added. Support for these amendments can be found variously throughout the specification, including, for example, original claim 1, paragraph [0017], and FIGS. 1-2. No new matter has been added. Accordingly, claims 1, 2, 4-7, 10, and 12-17 are presently pending in the application, each of which Applicant believes is in condition for allowance. Applicant respectfully requests reexamination and reconsideration in light of the above amendments and the following remarks.

For simplicity and clarity purposes in responding to the Office Action, Applicant’s remarks are primarily focused on the rejections applied to independent claim 1 as outlined in the Office Action with the understanding that the dependent claims are patentable for at least the same reasons (and in most cases other reasons) that independent claim 1 is patentable. Applicant expressly reserves the right to argue the patentability of the dependent claims separately in any future proceedings.

**Claim Rejections – 35 U.S.C. § 112 ¶2**

On page 2 of the Office Action, the Examiner rejected claim 3 under 35 U.S.C. § 112 ¶ 2. With this Amendment, claim 3 is canceled without prejudice or disclaimer as to its underlying subject matter. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

**New Claims**

Support for new claims 15-17 can be found variously throughout the specification, including, for example, paragraph [0017] and FIGS. 1-2. Applicant submits that each of these new claims is clearly distinguishable from the applied art of record and courteously solicits allowance of the same.

**Claim Rejections – 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,651,797 to Tree in view of U.S. Patent No. 5,542,520 to Beisel. The Examiner also rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Tree in view of Beisel, and further in view of U.S. Patent No. 5,531,309 to Kloss et al. The Examiner also rejected claims 5, 10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Tree in view of Beisel, further in view of Kloss, and still further in view of U.S. Patent No. 5,564,546 to Molbak. The Examiner also rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Tree in view of Beisel, and further in view of U.S. Patent No. 4,663,538 to Cotton. The Examiner also rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Tree in view of Beisel, further in view of Kloss and still further in view of U.S. Patent No. 5,282,765 to Suzuki. The Examiner also rejected claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Tree in view of Beisel, further in view of Kloss, further in view of Molbak, further in view of Suzuki, further in view of U.S. Patent No. 4,472,819 to Constantino, and still further in view of U.S. Patent No. 4,213,524 to Miyashita. Applicant respectfully traverses these rejections for at least the following reasons.

**Tree and Beisel fail to disclose, teach, or suggest each and every element recited in independent claim 1**

In order to establish a *prima facie* case of obviousness, the reference (or references when combined) must teach or suggest each and every claim element. *See, e.g., In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *accord.* MPEP 2143.03. Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

Independent claim 1 of the present application recites, *inter alia*, “a canister configured to accept and collect coins, said canister including a first end and a second end, said first end of said canister configured to accept said coins, said second end of said canister configured to collect said coins ... [an]entertainment device disposed between said first end and said second end of said canister, wherein said entertainment device includes at least three different movable items selected from the group of a lever, step, gear, ramp, rotating wheel, loop, cup, dish, and catapult ... wherein said entertainment device is configured to cause said coins, based on a value of said coins, to travel different paths and to travel through different combinations of the at least three different movable items during said coins’ travel from said first end to said second end.”

Tree, in contrast, clearly fails to disclose, teach, or suggest each and every limitation recited in independent claim 1. To begin with, at the very least, Tree fails to disclose, teach, or even suggest “a canister configured to accept and collect coins,” the canister having an “entertainment device disposed between said first end and said second end of said canister.”

Instead, Tree clearly discloses a storage receptacle 10 having at least two separate components: a detachable face 16 containing a “means for evoking a response of entertainment,” and a canister (*i.e.*, storage container 14) configured to accept coins discharged from the detachable face and configured to collect the coins.

For example, Tree clearly states that “[t]he storage receptacle 10, shown in FIGS. 1 and 1A, has two key components: a secure storage container 14, and a detachable face 16.” Col. 3, lines 26-29. Tree describes that detachable face 16 “is designed to include a means for evoking a response of entertainment or amusement from the user and may be replaced with other interchangeable faces” and “is constructed so as to be detachable from the secure storage container 14 ....” Col. 3, lines 28-32 (emphasis added). Tree further describes that, in contrast to detachable face 16, “secure storage container 14, is constructed to releasably receive the items of interest, such that means are provided for receiving the items, and means are provided for selectively preventing the removal of the items.” Col. 3, lines 40-44 (emphasis added).

It is clear that the only canister disclosed by Tree that is configured to both accept **and** collect coins is storage container 14. Tree clearly fails to disclose, teach, or suggest that storage container 14 includes an entertainment device disposed between a first end and a second end of storage container 14. Additionally, Tree makes clear that detachable face 16 is not part of the canister (*i.e.*, storage container 14), but rather, Tree teaches that detachable face 16 is merely an additional component containing a “means to evoke a response of entertainment” that may be attached or removed from front surface 18 of the canister. *See, e.g.*, Col. 3, lines 60-63; *see also* Col. 3, lines 50-54 (“... a means to evoke a response of entertainment, or amusement, is activated, and the coin then moves through the face 16 into the secure storage container 14

through coin entrance 24.”). Therefore, Tree fails to disclose, teach, or suggest an entertainment device disposed between a first end and a second end of a canister (*i.e.*, storage container 14).

Beisel fails to remedy the deficiencies in Tree described above. For example, Beisel fails to disclose, teach, or suggest a “a canister configured to accept and collect coins,” the canister having an “entertainment device disposed between said first end and said second end of said canister.” Instead, Beisel merely describes a testing apparatus for testing processed coins or round discs that does not include either a canister or an entertainment device. *See, e.g.*, Col. 1, lines 15-22 and FIG. 1.

Accordingly, because Tree and Beisel, either alone or in combination, fail to disclose, teach or suggest each and every element of independent claim 1, a *prima facie* case of obviousness has not been established. *See, e.g., In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art); *accord.* MPEP § 2143.03 (“To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.”) (emphasis added). Applicant therefore respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

Claims 2, 4-7, 10, and 12-14 depend directly or indirectly from claim 1. By virtue of this dependency, Applicant submits that claims 2, 4-7, 10, and 12-14 are allowable for at least the same reasons given above with respect to claim 1. In addition, Applicant submits that claims 2, 4-7, 10, and 12-14 are further distinguished over cited art by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully

requests, therefore, that the rejection of claims 2, 4-7, 10, and 12-14 under 35 U.S.C. § 103(a) be withdrawn.

**The Examiner's proposed combination of Tree and Beisel would destroy a main object of the Tree invention**

Any attempt to combine the teachings of Beisel, specifically the alleged teaching of the coin testing apparatus, with the in-wall novelty coin bank of Tree destroys a main object of the Tree invention, further weakening the Examiner's alleged motivation to combine. *See, e.g., In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *accord.* MPEP 2143.01 ("If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification"); *accord.* MPEP 2143.01. As established by the federal courts, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); *accord.* MPEP 2143.01.

For example, Tree clearly states that an "object of the present invention" is "to provide a means to securely store items of interest and which does not take up a substantial amount of household storage space." Col. 1, lines 55-59 (emphasis added). Tree further states that the storage means has an "in-wall design [that] allows the device to be used in households to securely hold items of interest while conserving storage space." Col. 2, lines 14-18 (emphasis

added); *see also* Col. 3, lines 11-13 (“Installing the device in a wall of a home or building reduces the displacement of space.”).

In contrast to the space conserving coin bank disclosed in Tree, Beisel discloses a relatively large and space consuming testing apparatus for use in conjunction with the processing of discs, such as coins processed in a “coining press.” *See, e.g.*, Col. 1, lines 15-22 (“Testing apparatuses of this type are used to check coins or coin blanks in various processing stages for dimensional accuracy .... Previously, these tests have occurred immediately before or after the machine that carries out the individual processing step, for example a coining press.”). The testing apparatus of Beisel is clearly not sized or configured to conserve space in a home, as taught in Tree.

As described in detail above, Tree fails to disclose, teach, or even suggest “a canister configured to accept and collect coins” having an “entertainment device disposed between said first end and said second end of said canister.” However, assuming, *arguendo*, one were to attempt to combine the testing apparatus shown and described in Beisel with the “means for evoking a response of entertainment” disposed inside the detachable face 16 shown and described in Tree, the space requirements for the coin bank of Tree would have to increase significantly to accommodate the testing apparatus of Beisel. This would clearly destroy the object of the Tree invention “to provide a means to securely store items of interest and which does not take up a substantial amount of household storage space.”

The relative dimensions of the coin bank in Tree and the testing apparatus in Beisel are evidenced by the illustrations and description in Tree and Beisel. *See, e.g.* Col. 4, lines 1-7 and FIG. 2 of Tree (showing representative dimensions of the coin bank in relation to studs in a

household wall); *see also* Col. 4, line 33-39 and FIG 1. of Beisel (showing representative dimensions of the testing apparatus in relation to discs, such as finish-minted coins).

Accordingly, it is clear that the testing apparatus of Beisel could not be combined with the coin bank of Tree without destroying the object of the Tree invention “to provide a means to securely store items of interest and which does not take up a substantial amount of household storage space.” Applicant therefore respectfully requests withdrawal of this rejection.

**The Examiner’s proposed combination of Tree and Beisel could not reasonably be expected to be successful**

In order to establish a *prima facie* case of obviousness, there must be a reasonable expectation that the proposed modifications or combination would be successful. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375 (Fed. Cir. 1986); *accord*.

As described in detail above, Tree fails to disclose, teach, or even suggest “a canister configured to accept and collect coins” having an “entertainment device disposed between said first end and said second end of said canister.” However, assuming, *arguendo*, one were to consider combining the testing apparatus shown and described in Beisel with the “means for evoking a response of entertainment” disposed inside the detachable face 16 shown and described in Tree, there would not be a reasonable expectation that the proposed combination would be successful.

For example, in order to combine the testing apparatus of Beisel with the coin bank of Tree in the manner suggested by the Examiner, the testing apparatus of Beisel would necessarily need to be disposed in the coin bank such that it comprises part of the “means to evoke a

response of entertainment” disposed within detachable face 16. As described in Tree, an object of the Tree invention is “to provide a means to securely store items of interest and which does not take up a substantial amount of household storage space.” Col. 1, lines 55-59. One could not reasonably expect that the testing apparatus of Beisel could be substantially decreased in size such that it could fit within detachable face 16 and such that it could still operate to test coins in the manner described in Beisel.

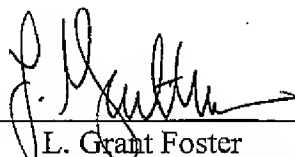
Accordingly, it is clear that there does not exist a reasonable expectation that the testing apparatus of Beisel could be combined with the coin bank of Tree “which does not take up a substantial amount of household storage space.” *See, e.g., In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375 (Fed. Cir. 1986). Applicant therefore respectfully requests withdrawal of this rejection.

**Conclusion**

Applicant respectfully submits that the present Application is in condition for allowance. Applicant requests reconsideration and allowance of the pending claims. Applicant invites the Examiner to contact the undersigned by telephone to expedite the prosecution of the present application if there remain any unresolved issues.

Respectfully submitted,

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